REMARKS

The Office Action mailed April 24, 2003 has been reviewed and the comments of the Patent and Trademark Office have been considered. Claims 1-22 were pending in the application. Claims 1, 2, 5-11, and 14-22 have been amended, claims 12 and 13 have been canceled and no claims have been newly added. Therefore, claims 1-11 and 14-22 are pending in the application and submitted for reconsideration.

An Information Disclosure Statement submitting the references listed in the specification is being filed concurrently herewith.

In reply to the objection in paragraph 2 of the Office Action, applicants have submitted a substitute abstract, attached on a separate page at the end of this Amendment, that should not be objectionable. No new matter is added.

This amendment changes and deletes claims in this application. A detailed listing of all claims that are, or were, in the application, irrespective of whether the claims remain under examination in the application, are presented, with an appropriate defined status identifier.

Claims 9-12 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In reply, applicants have amended the claims to address the issues noted in paragraph 4 of the Office Action and submit that the pending claims are in definite form and meet the requirements of § 112, second paragraph.

In the Office Action, claims 1, 2, 14, and 15 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. patent 6,490,521 to Wiener (hereafter "Wiener") in view of U.S. patent 6,347,278 to Ito (hereafter "Ito"). Claims 3-8, 12, 13, and 16-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiener in view of Ito and further in view of U.S. patent 6,324,467 to Machii et al. (hereafter "Machii"). Claims 9-11 and 20-22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wiener in view of Ito and further in view of U.S. patent application 2001/0056443 to Takayama et al. (hereafter "Takayama"). Applicants respectfully traverse these rejections for the following reasons.

The independent claims 1 and 14 recite an image forming system including a printer that is configured, *inter alia*, such that the printer receives map data comprising a position data of the printer as a starting point and a desired destination data (received from a user from a portable terminal) as an ending point via a network. The printer can, therefore, print a map

based on the map data so that a user has a useful map from a relevant and accessible intermediate point (the location of the printer) to the user's destination. Such a printed map is otherwise not easily available to user of a portable terminal (such as a cellular phone) as discussed in the specification at pages 1-4. The primary cited prior art appears to suffer from problems discussed in the specification at these pages.

None of the cited prior art discloses either the features or the advantages of the claimed invention. Specifically, Weiner discloses that a navigation system 100 provides navigation information to the subscriber unit 35 based on a position of the subscriber unit 35 and a desired destination. See, for example, col. 3, lines 30-44 of Weiner. The <u>subscriber unit 35</u> is <u>associated with the *location* of the *user*, for example, it may be mounted on a vehicle or on a personal transportation device such as a golf cart or bicycle (or in a cell phone, etc.). See col. 4, lines 1-14 of Weiner. Accordingly, it is clear that Weiner does <u>not</u> teach or suggest the recited feature that a printer (separate from the portable terminal associated with the user) receives map data comprising a <u>position data of the printer</u> as a <u>starting location</u> and the desired destination data as the ending point. As discussed in the specification, the printer may be located, for example, at an on-route printer that prints a map image on a recording medium. See, for example, page 9, lines 13-24.</u>

This deficiency in Weiner is not cured by any of the other relied-upon references. Ito relates to a navigation system 101 in which a CD-ROM located at the mobile terminal is replaced with information provided by a server 102. There is <u>no</u> disclosure or suggestion of the claimed printer that receives map data comprising a position data <u>of the printer</u> as a starting point and a destination data (received from a user from a portable terminal separate from the printer) as an ending point via a network. Neither Machii or Takeyama, that are cited against the dependent claims, disclose or suggest the claimed printer as discussed above. Accordingly, the independent claims are believed to be patentable over the applied prior art.

The dependent claims are also believed to be patentable for at least the same reasons as the respective independent claims on which they ultimately depend. In addition, they recite additional features which are also patentable when considered as a <u>whole</u>.

In view of the foregoing amendments and remarks, applicants respectfully submit that the application is now in condition for allowance. An early notice to this effect is earnestly solicited. If there are any questions regarding the application, or if an examiner's amendment would facilitate the allowance of one or more of the claims, the examiner is invited to contact the undersigned attorney at the local telephone number below.

Respectfully submitted,

Date July 24, 2003

FOLEY & LARDNER

Customer Number: 22428

22428
PATENT TRADEMARK OFFICE

Telephone:

(202) 672-5414

Facsimile:

(202) 672-5399

Attached: substitute abstract

y <u>Darou C. Cha</u>

Pavan K. Agarwal Registration No. 40,888

Aaron C. Chatterjee Registration No. 41,398

Attorneys for Applicant

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge deposit account No. 19-0741 for any such fees; and applicants hereby petition for any needed extension of time.